

Application No. 09/932,430
Amendment dated May 11, 2005
Reply to Office Action of January 11, 2005

REMARKS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to the claims and the following comments.

In the Office Action mailed January 11, 2005, claims 13-17, 19, 21, 30-33, and 38-54 were rejected under 35 U.S.C. §103(a), as allegedly obvious over one or more of the following references: U.S. Patent No. 5,346,217 to Tsuchiya ("Tsuchiya '217"); U.S. Patent No. 6,440,011 to Hocknell et al. ("Hocknell '011"); Japanese Publication No. 2001-029518 ("JP Pub. '518"); and U.S. Patent No. 6,162,133 to Peterson ("Peterson '133").

For economy of prosecution, Applicants have canceled claims 13-17, 19, 21, 30-33, 36, and 38, by this Amendment. Applicants respectfully traverse the rejections on the remaining claims, for the reasons set forth below.

35 U.S.C. § 103(a) Rejection of Claims 39 and 54 Over Tsuchiya '217

The Examiner has rejected independent claims 39 and 54 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchiya '217.

Tsuchiya '217 discloses joining several separately formed pieces to form a golf club head (Figs. 4, 7, 8). Although the Examiner implicitly admits that Tsuchiya '217 fails to disclose forming a unitary body having a crown, a skirt, and a sole, as recited in claims 39 and 54, the Examiner states that it would have been obvious to fabricate a unitary club head having dimensions similar to those disclosed in Tsuchiya '217 since it has been held that a one-piece construction versus several parts secured together as a single unit is an obvious matter of design choice. *See In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

In response, Applicants point to *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), where the Federal Circuit held that a unitary versus multi-piece construction was patentable where the unitary construction was contrary to the understandings and expectations of the art.

In the present case, Tsuchiya '217 teaches against forming a unitary club head body as recited in claims 39 and 54. For example, Tsuchiya '217 states that "[t]it is infeasible

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with such cast material to produce a hollow construction with a thin shell because of various process demands in production . . . These process demands all hinder formation of a thin shell for the light weight, large hollow construction of the club head." (col. 2, lines 26-35.) Tsuchiya '217 further states that "[u]se of a shell construction made of metallic material subjected to plastic working enables formation of a very thin shell including no ribs. Uniform ace condition is thereby obtained without the danger of the conventional cast defect generation." (col. 6, lines 47-51.) Clearly the construction method recited in claims 39 and 54 is contrary to the understandings and expectations disclosed by Tsuchiya '217.

Because Tsuchiya '217 teaches against forming a unitary club head body, claims 39 and 54 are not obvious in view of Tsuchiya '217.

35 U.S.C. § 103(a) Rejection of Claims 39 and 54 Over Tsuchiya '217 in View of Peterson '133

The Examiner has further rejected claims 39 and 54 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchiya '217, stating that unitary golf club heads are conventional in the art to enhance construction uniformity, control weight distribution, and reduce manufacturing costs. The Examiner points to Peterson '133 as support for these purported benefits.

Peterson '133 discloses a golf club head with a unitary body including a face plate, a top crown, and a sole plate. Despite the Examiner's assertions otherwise, Peterson '133 implicitly teaches against a unitary body and a separately formed striking plate, as recited in claims 39 and 54. For example, every example disclosed in Peterson '133 requires that the striking plate be formed integrally with at least one other portion of the golf club head, such as the crown, sole, and skirt. (col. 3, lines 1-21) Additionally, Peterson '133 teaches that forming the face plate integrally with another portion of the head enhances manufacturing repeatability with respect to loft, lie, and face angle. (col. 4, lines 24-34.)

Because Peterson '133 teaches against a unitary body and a separately formed striking plate, claims 39 and 54 are not obvious in view of Peterson '133.

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If the Examiner still believes unitary construction is conventional in the art, in accordance with 37 C.F.R. § 1.104(d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit and/or references that evidence the asserted common knowledge (or personal knowledge of the Examiner). Appellants further request that the Examiner identify in the prior art a suggestion or motivation for combining in the manner prescribed. See *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite references to support its conclusions as PTO must document its reasoning on the record to allow accountability and effective appellate review); see also MPEP 2144.03 ("A seasonable challenge (to a statement of "well known" art) constitutes a demand for evidence made as soon as practicable during prosecution.").

35 U.S.C. § 103(a) Rejection of Claim 39 Over Hocknell '011 in view of Peterson '133

The Examiner has also rejected claim 39 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hocknell '011 in view of Peterson '133. As support for this position, the Examiner maintains the same arguments made with respect to claim 39 in previous office actions.

Applicants have argued that Hocknell '011 fails to disclose a crown having a thickness of less than about 0.8 mm over at least a crown transition distance of about 20 mm measured rearward from the front opening. In response, the Examiner points to the specification of the present application as merely disclosing a crown having a "designated" transition region Rc with the same thickness as the rest of the crown but no structural difference between the transition region versus the majority of the crown.

The Examiner appears to be stating that the specification of the current application does not provide support for a crown having a crown transition region thickness that differs from that of the rest of the crown. Applicants respectfully disagree with this assertion as the specification clearly does not require that the thickness of the entire crown be less than 0.8 mm.

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Additionally, as previously noted in the Amendment dated October 5, 2004, the upper lateral extension 76 in Hocknell '011 is distinguished as a separate component from the crown 62. Although Hocknell '011 discloses a thickness for the crown 62, no thickness is disclosed for the upper lateral extension 76. As a result, Hocknell '011 fails to disclose a golf club head having a crown transition region according to the limitations recited in claim 39.

35 U.S.C. § 103(a) Rejection of Claim 54 Over Hocknell '011 in view of Peterson '133

The Examiner has also rejected claim 54 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hocknell '011 in view of Peterson '133. As support for this position, the Examiner maintains the same arguments made with respect to claim 54 in previous office actions.

Applicants have argued that Hocknell '011 fails to disclose a sole having a thickness of less than about 1.0 mm over at least a sole transition distance of about 20 mm measured rearward from the front opening. In response, the Examiner points to the specification of the present application as merely disclosing a sole having a "designated" transition region Rs with the same thickness as the rest of the sole but no structural difference between the transition region versus the majority of the sole.

The Examiner appears to be stating that the specification does not provide support for a sole having a sole transition region thickness that differs from that of the rest of the sole. Applicants respectfully disagree with this assertion as the specification clearly does not require that the thickness of the entire sole be less than 1.0 mm.

Additionally, as previously noted in the response dated 10/5/2004, the lower lateral extension 78 in Hocknell '011 is distinguished as a separate component from the sole 64. Although Hocknell '011 discloses a thickness for the sole 64, no thickness is disclosed for the lower lateral extension 78. As a result, Hocknell '011 fails to disclose a golf club having a sole transition region according to the limitations recited in claim 54.

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35 U.S.C. § 103(a) Rejection of Claims 39 and 54 in view of U.S. Patent No. 6,364,789 and U.S. Patent No. 6,491,592

Referencing U.S. Patent No. 6,364,789 and U.S. Patent No. 6,491,592, the Examiner states that "crown transition region(s) either have a thinner or thicker region from its major crown portion".

Applicants respectfully request that the Examiner point out specifically where these references disclose crown and sole transition regions having the limitations recited in claims 39 and 54, respectively.

If the Examiner believes the limitations recited in claims 39 and 54 are obvious in view of these references, in accordance with 37 C.F.R. § 1.104(d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit and/or references that evidence the asserted common knowledge (or personal knowledge of the Examiner). Appellants further request that the Examiner identify in the prior art a suggestion or motivation for combining in the manner prescribed. *See In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite references to support its conclusions as PTO must document its reasoning on the record to allow accountability and effective appellate review); *see also* MPEP 2144.03 ("A seasonable challenge (to a statement of "well known" art) constitutes a demand for evidence made as soon as practicable during prosecution.").

Dependent Claims 40-53

Dependent claims 40-53 depend from independent claim 39 and are allowable over the prior art for at least the same reasons discussed above with respect to claim 39, as well as for their respective attributes.

New Claims 55-68

New dependent claims 55-68 depend from independent claim 54. Therefore, claims 55-68 are allowable over the prior art for at least the same reasons claim 54 is allowable, as well as for their respective attributes.

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CONCLUSION

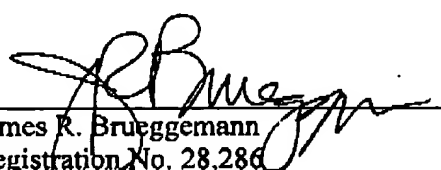
The foregoing amendments and remarks should place this application in condition for allowance. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, the Examiner is respectfully requested to call the undersigned attorney at the number indicated below.

Date: May 11, 2005

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON ^{LLP}

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